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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,350	06/13/2005	Donald Paul Gardner	A36426-PCT-USA (072819.01)	3933
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EXAMINER FONSECA, JESSIE T				
ART UNIT 3633		PAPER NUMBER		
NOTIFICATION DATE 04/16/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DL.NYDOCKET@BAKERBOTTS.COM

### Office Action Summary

**Application No.**

10/517,350

**Applicant(s)**

GARDNER, DONALD PAUL

**Examiner**

JESSIE FONSECA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/15/08 has been entered.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities:

Claim 7, line 3: When reciting the particulate embedded in the decorative upper surface, it appears applicant inadvertently used the word "proud". It appears applicant meant to use the word --protruding--? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claims 9-10: The scope of the claims is unclear, as both claims 9-10 depend off canceled claim 8. For the purpose of examination, claims 9-10 will be considered to be dependent upon claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11-15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kotler (US 4,860,510).

With regards to claim 1: Kotler discloses a ventilating decorative floor covering (10) being a plastics floor covering (col. 4, line 65 – col. 5, line 6; and col. 5, lines 41-45) and having a decorative upper surface (col. 5, lines 16-19) and a lower surface on which are formed one or more studs (19) (figs. 1-2) (col. 5, lines 16-19).

The floor covering of Kotler is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regards to claim 11: Kotler further disclose the floor covering is a heterogeneous floor covering (fig. 1)

With regards to claim 12: The flat finish of Kotler which is adapted for foot traffic is considered a wear layer (col. 5, lines 16-19).

With regards to claim 13: Kotler further disclose the upper surface includes a flat finish or can be textured (col. 5, lines 16-19).

With regards to claim 14: Kotler further discloses a support, such as a support grid (11).

With regards to claim 15: Kotler discloses a ventilating decorative floor covering (10) being a plastics floor covering (col. 4, line 65 – col. 5, line 6; and col. 5, lines 41-45) and having a decorative upper surface and a lower surface on which are formed one or more studs (19) (figs. 1-2) (col. 5, lines 16-19) to provide an air gap between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor (col. 1, lines 10-15)

With regards to claim 18: Kotler discloses a combination of a floor having an upper surface (col. 1, line 10-14) and a ventilating decorative floor covering (10) for loose laying on the upper surface of the floor wherein the floor covering is a plastics floor covering (col. 4, line 65 – col. 5, line 6; and col. 5, lines 41-45) and has a decorative upper surface (col. 5, lines 16-19) and a lower surface on which are formed one or more studs (9) so that an air gap is formed between the lower surface of the floor

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covering and the upper surface of the floor sufficient to ventilate the floor (col. 1, lines 6-14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 9, 11-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863).

With regards to claim 1: Shortland et al. discloses a decorative plastics floor covering comprising a decorative upper surface (fig. 1; pg. 1, lines 1-5; pg. 6, lines 21-25).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering.

However, Oakley discloses flooring tile having one or more studs formed on the lower surface so as to provide ventilation (col. 4, lines 71-78; figs. 1-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide means for ventilation (col. 4, lines 71-78)

The floor covering of Shortland et al., in view of Oakley, is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regards to claims 2, 3, & 5: Shortland et al. further discloses the modification of the floor surface (1) in the form of a softening agent, such as a plasticizer (page 8, lines 5-10). As disclosed by the applicant on lines 24-26, page 3 of the disclosure, the lower surface can be softened using a plasticizer. It is noted that any amount of plasticizer other than the minimum amount used is considered additional plasticizer. Therefore, the floor covering of Shortland et al. including a plasticizer is considered equivalent to that of applicant's.

With regards to claim 6: Shortland et al. further discloses one or more particulate materials (6) in the upper surface of the floor covering (1) to provide slip resistance (fig. 1; abstract; page 3, lines 7-15 & lines 20-23).

With regards to claim 7: Shortland et al. further discloses the particulate material (6) is embedded in the decorative upper surface of the flooring covering (1) is at least partially protruding from the upper surface to achieve adequate slip resistance (fig. 1; col. 3, lines 7-15).

With regards to claim 9: Shortland et al. further discloses the plastics material is selected from a group consisting of PVC, plasticized acrylic, polyester, and a PVC plastisol material (fig. 1; pg. 3, lines 7-15).

With regards to claim 11: Shortland et al., further discloses the floor covering is heterogeneous flooring covering (fig. 1).

With regards to claim 12: Shortland et al. further discloses wear layer (3) (fig. 1).

With regards to claim 13: Shortland et al. further discloses a pigment (pg. 8, lines 6-8) and pigmented PVC chips (pg. 3, lines 20-23).

With regards to claim 14: Shortland et al. further discloses a reinforcing support, preferably a glass fibre reinforced non-woven supports (page 2, lines 21-22).

With regards to claim 15: Shortland et al. discloses a floor covering (1) having a decorative upper surface (page 3, lines 7-11) and a lower surface (fig. 1).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering, where an air gap is formed between the lower surface of the floor covering and the upper surface of the floor

However, Oakley discloses flooring tile having one or more studs formed on the lower surface so as to provide ventilation when laying the floor covering on a floor (col. 1, lines 9-11; col. 4, lines 71-78).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to



include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide means for ventilation (col. 4, lines 71-78)

With regards to claim 17: Shortland et al. further discloses the floor covering (1) is a slip resistant floor covering (page. 3, lines 7-11)

With regards to claim 18: Shortland et al. discloses a floor covering (1) having a decorative upper surface (page 3, lines 7-11) and a lower surface (fig. 1).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering, where an air gap is formed between the lower surface of the floor covering and the upper surface of the floor

However, Oakley discloses flooring tile having one or more studs formed on the lower surface so as to provide ventilation when laying the floor covering on a floor (col. 1, lines 9-11; col. 4, lines 71-78).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide a means for ventilation (col. 4, lines 71-78)

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863) and in further view of Fanti (US 2001/0034983 A1).

With regards to claim 4: Shortland, in view of Oakley, discloses everything previously mentioned, but fails to disclose the being the lower surface being roughened to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which is applied.

However, Fanti discloses a flooring covering (par. 0001) having a roughened surface lower surface to enhance the securement of the flooring to the surface in which it is to be laid (par. 0015).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the floor covering of Kotler to include a roughened lower surface as taught by Fanti in order to provide a lower surface having a greater coefficient of friction with the surface in which it was laid for increased stability and securement.

The limitation "by including a blowing agent in the material from which the lower surface of the floor covering is formed" renders the claim a product by process claim. It is noted that although product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863), and in further view of Bergishagen (US 5,063,251).

With regards to claim 10: Shortland et al. further discloses the plastics material is in the amount of 100 to 200 parts per hundred part of plastics material (php), a filler preferably in the amount of 0 to 100 php, thermal stabilizer preferably in an amount of 1 to 3 php, and/or a pigment preferable in amount of 1 to 3 php (page 8, lines 5-8). It is noted that the Examiner considers the unit, Phr (parts per hundred of resin), to be equivalent to unit, Php (parts per hundred parts of plastic), as both pertain to a plastisol material.

Shortland et al., previously modified by Oakley, discloses everything previously mentioned, but fails to disclose a blowing agent in an amount of 0 to 2 php.

However, Bergishagen discloses a blowing agent for use with flooring tile (col. 1, lines 33-35), where a cell structure is formed when a blowing agent is used with conjunction of plastic material (col. 1, line 59 - col. 2, lines 4). Bergishagen further discloses a blowing agent preferably in an amount from 0 to 2 php (col. 4, lines 44-61).

Therefore, it would obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al., in view of Oakley, to include a blowing agent in the amount of 0 to 2 php as taught by Bergishagen in order to expand of the floor covering plastic material for a light-weight plastic foam structure.

Claims 2-4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotler (US 4,860,510) in view to Fanti (US 2001/0034983 A1)

With regards to claim 2-4: Kotler discloses everything previously mentioned, but fails to disclose the being the lower surface being modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which is applied

However, Fanti discloses a flooring covering (par. 0001) having a roughened surface lower surface to enhance the securement of the flooring to the surface in which it is to be laid (par. 0015). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the floor covering of Kotler to include a roughened lower surface as taught by Fanti in order to provide a lower surface having a greater coefficient of friction with the surface in which it was laid for increased stability and securement.

The limitation "by including a blowing agent in the material from which the lower surface of the floor covering is formed" renders the claim a product by process claim. It is noted that although product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

With regards to claim 19: Kotler discloses a ventilating decorative floor covering (10) being a plastics floor covering (col. 4, line 65 – col. 5, line 6; and col. 5, lines 41-45) and having a decorative upper surface and a lower surface on which are formed one or more studs (19) (figs. 1-2) (col. 5, lines 16-19).

The floor covering of Kotler is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Kotler, discloses everything previously mentioned, but fails to disclose the being the lower surface being modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which is applied

However, Fanti discloses a flooring covering (par. 0001) having a roughened surface lower surface to enhance the securement of the flooring to the surface in which it is to be laid (par. 0015).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the floor covering of Kotler to include a roughened lower surface as taught by Fanti in order to provide a lower surface having a greater coefficient of friction with the surface in which it was laid for increased stability and securement.

### **Response to Arguments**

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. F./

Examiner, Art Unit 3633

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635